EXHIBIT 1

Dockets.Justia.com

UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
(Alexandria Division)

TRIANTAFYLLOS TAFAS,	)
Plaintiff,	)
	) **CIVIL ACTION: 1:07-CV-00846-JCC-TRJ**
v.	)
	)
JON W. DUDAS, in his official	)
capacity as Undersecretary of	)
Commerce for Intellectual Property	)
and Director of the United States	)
Patent and Trademark Office, et al.,	)
Defendants.	)

CONSOLIDATED WITH

SMITHKLINE BEECHAM	)
CORPORATION, et al.,	)
Plaintiffs,	) **CIVIL ACTION: 1:07-CV-00846-JCC-TRJ**
	)
v.	)
	)
JON W. DUDAS, in his official	)
capacity as Undersecretary of	)
Commerce for Intellectual Property	)
and Director of the United States	)
Patent and Trademark Office, et al.,	)
Defendants.	)

SECOND AMENDED CERTIFICATION OF THE ADMINISTRATIVE RECORD BY THE UNITED STATES PATENT AND TRADEMARK OFFICE

Declaration of Jennifer M. McDowell

I, Jennifer M. McDowell, hereby declare:

1. I am employed by the United States Patent and Trademark Office ("USPTO").

During the period from January 3, 2006 through the present, I have been an attorney in the USPTO's Office of General Counsel, Office of General Law.

2. As an attorney in the Office of General Law, I am responsible for the administrative clearance of Agency rule makings.

3. In connection with these duties, I have knowledge of the record-keeping practices of the USPTO relating to rule makings.

4. The above-referenced action is a challenge to USPTO final rules, Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications. 72 FR 46716-46843 (August 21, 2007).

5. On October 5, 2007 and January 16, 2008, I certified that the administrative record provided to the Court at A00001-A09622 and SA001-101 were, to the best of my knowledge, a true, correct and complete copy of the administrative record in this matter.

6. As a result of summary judgment briefing, on January 22, 2008, it came to my attention that a two-page document, the Agency's Regulatory Flexibility Act certification of the notice of proposed rulemaking concerning the claims rule, was inadvertently omitted from the administrative record.

7. The information contained in that four-paragraph document is included in the existing administrative record. See Changes to Practice for the Examination of Claims in Patent Applications, 71 Fed. Reg. 61, 66 (2006) (A00006). The first paragraph of the document is conveyed in substance in the referenced Federal Register notice, and the second through fourth paragraphs of the document are reproduced verbatim. See id.

8. With the addition of the document annexed hereto as SA102-SA103, the administrative record that I certified on October 5, 2007 and January 16, 2008 is, to the best of my knowledge, true, accurate, and complete.

I certify under penalty of perjury that the foregoing is true and correct.

Dated: January 22, 2008.

JENNIFER M. MCDOWELL

UNITED STATES PATENT AND TRADEMARK OFFICE

GENERAL COUNSEL

NOV 2 5 2005

MEMORANDUM FOR: Thomas M. Sullivan
Chief Counsel for Advocacy
Small Business Administration

FROM: Bernard J. Knight, Jr.
Deputy General Counsel for General Law

SUBJECT: Certification Under 605(b) of the
Regulatory Flexibility Act

The Deputy General Counsel for General Law of the United States Patent and Trademark Office certifies to the Chief Counsel for Advocacy of the Small Business Administration that this notice of proposed rule making, Changes to Practice for the Examination of Claims in Patent Applications (RIN 0651-AB94), will not have a significant economic impact on a substantial number of small entities. See 5 U.S.C. 605(b).

This notice proposes to require an examination support document that covers each independent claim and each dependent claim designated for initial examination if: (1) the application contains or is amended to contain more than ten independent claims; or (2) the number of independent claims plus the number of dependent claims designated for initial examination is greater than ten. There are no fees associated with this proposed rule change.

The changes proposed in this notice will not affect a substantial number of small entities. The Office's PALM records (PALM records as of October 13, 2005) show that the Office has received 216,327 nonprovisional applications (65,785 small entity) since January 1, 2005, with about 2,522 (866 small entity) of these nonprovisional applications including more than ten independent claims. Thus, since January 1, 2005, only 1.2 percent of all nonprovisional applications and 1.3 percent of the small entity nonprovisional applications contain or were amended to contain more than ten independent claims. In addition, Office experience is that most applications which contain more than ten independent claims contain claims that are directed to inventions that are independent and distinct under 35 U.S.C. 121, and the proposed rule permits an applicant to avoid submitting an examination support document by suggesting a requirement for restriction accompanied by an election of an invention to which there are drawn no more than ten independent claims. Therefore, the Office estimates that the proposed examination support document requirement would not impact a substantial number of small entities.

SA102

It is also noted that the proposed rule change would not disproportionately impact small entity applicants.

The changes proposed in this notice will not have a significant economic impact upon small entities. The primary impact of this change would be to require applicants who submit an excessive number of claims to share the burden of examining the application by filing an examination support document covering the independent claims and the designated dependent claims. There are no fees associated with this proposed rule change. The American Intellectual Property Law Association (AIPLA) 2003 Report of the Economic Survey indicates that the seventy-fifth percentile charge (for those reporting) for a patent novelty search, analysis, and opinion was $2,500.00. Given that the pre-filing preparation of an application containing more than ten independent claims should involve obtaining such a patent novelty search, analysis, and opinion, the Office does not consider the additional cost of providing an examination support document to be a significant economic impact on an applicant who is submitting an application containing more than ten independent claims. In any event, any applicant may avoid the costs of such an examination support document simply by refraining from presenting more than ten independent claims in an application.